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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,003	04/28/2005	Helene Margaret Finney	CELL-0296	1691
20306 7590 03/12/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
SHEN, WU CHENG WINSTON				
ART UNIT		PAPER NUMBER		
1632				
MAIL DATE		DELIVERY MODE		
03/12/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/533,003

**Applicant(s)**

FINNEY ET AL.

**Examiner**

WU-CHENG Winston SHEN

**Art Unit**

1632

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1,2,6,8,9,11,12,17-19,21,25,26,28,30 and 37  
Claim(s) withdrawn from consideration: \_\_\_\_\_

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

/Valarie Bertoglio/  
Primary Examiner  
Art Unit 1632

Continuation of 3. NOTE: The proposed amendments in claims 1, 9, 12, 17, 19, which added limitation "KKKYSSSVHDPNGEYMFMRVNTAKKSRLTDVTL (SEQ ID NO 1)", change the scope of the invention in terms of requiring SEQ ID No: 1 being the cytoplasmic signaling sequence. The proposed amended claims 1, 9, 12, 17, 19 have been narrowed in scope and require a new search. The claims were generic and broad and encompassed more than ICOS as a human inducible costimulator. The claim amendments, if entered, would overcome the art rejections of record, thus a new search of the art would be required for the proposed species.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicant's reply has not overcome any rejection of record as all arguments rely on proposed, but not entered, claim amendments.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments have failed to overcome the rejection of claims 1, 2, 6, 8, 9, 11, 12, 17-19, 21, 25, 26, 28, 30 and 37 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.

Applicant's arguments have failed to overcome the rejection of claims 1, 2, 6, 8, 9, 11, 12, 17-19, 21, 25, 26, 28, 30 and 37 under 35 U.S.C. 102(b) as being anticipated by the prior art, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention because Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.

Applicant's arguments have failed to overcome the rejection of claims 1, 2, 6, 8, 9, 11, 12, 17-19, 21, 25, 26, 28, 30, and 37 under 35 U.S.C. 102(b) as being anticipated by Roberts et al., (Roberts et al., PCT/US96/01293, WO 96/23814, listed in IDS filed by the applicants) because Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.

Applicant's arguments have failed to overcome the rejection of claims 1, 2, 6, 8, 9, 11, 12, 17-19, 21, 25, 26, 28, 30, and 37 under 35 U.S.C. 102(b) as being anticipated by Finney et al. (Finney et al., PCT/GB96/04611, WO 02/33101, international publication date, April 25, 2002, listed in IDS filed by the applicants) because Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.

Applicant's arguments have failed to overcome the rejection of claims 1, 2, 6, 8, 9, 11, 12, 17-19, 21, 25, 26, 28, 30, and 37 under 35 U.S.C. 102(b) as being anticipated by Maher et al., (Maher et al., Human T-lymphocyte cytotoxicity and proliferation directed by a single chimeric TCR-CD28 receptor. Nat Biotechnol. 20(1): 70-5, Jan. 2002; listed in the IDS filed by the applicants) as evidenced by Hufloff et al. (Hufloff et al., ICOS is an inducible T-cell co-stimulator structurally and functionally related to CD28. Nature 397(6716): 263-6, 1999, listed in IDS filed by the applicants). because Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.